

REPLY UNDER 37 C.F.R. §1.116  
U.S. Appln. No. 09/823,458

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### **REMARKS**

Claims 38-50 are all the claims pending in the application. All pending claims stand rejected. Reconsideration and allowance of claims 38-50 are respectfully requested in view of the remarks the follow.

### **CLAIM REJECTIONS**

#### **35 U.S.C. § 103**

1.) Claims 38, 40-42 and 44-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,353,398 to Amin et al (hereinafter "Amin") in view of U.S. Patent 6,812,860 to Schwarzwald Jr (hereinafter "Shwarzwalder"). Applicant respectfully traverses this rejection for the following reasons.

#### **Legal Standard**

It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary sill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not

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render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

### Argument

The Office Action alleges Amin discloses all of the limitations of Applicant's independent claims 38, 42 and 47 with the exception of *one or more criteria specified by the user is price criteria* (or similar limitations present in the independent claims). The Office Action relies on Schwarzwaldner to make up for this deficiency alleging it would be obvious to modify the Amin system so that it would be capable of providing information based on price criteria because "it would be advantageous to users who have a spending budget limit." (6/14/06 Final Office Action pg. 3).

Applicant respectfully disagrees and submit that *prima facie* obviousness has not been established because (i) there is no proper motivation to combine references as suggested; and (ii) even if it were proper to combine references as proposed in the Office Action, all of the limitations present in Applicant's claims are not disclosed or suggested.

### NO PROPER MOTIVATION TO COMBINE AMIN WITH SCHWARZWALDER

Amin discloses a system in which a global positioning directed information system (GPDIS) 30 which is itself a global positioning satellite system tied to information databases or servers and is used to determine the location of a mobile user and to push, substantially unsolicited, information to a user. (Col. 3, ll. 3, 14, 35, 41, 44, 48, 55, 63, 66 and col. 4, ll. 1, 16, 25). The push technology disclosed primarily by Amin is entirely unrelated to Applicant's claims or the system disclosed by Schwarzwaldner. However, Amin does disclose one brief embodiment, referring to Fig. 4, in which a user can submit real-time "queries" directed to global positioning directed information system (GPDIS) 20. (Col. 4, ll. 29-50). In this brief mention by

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Amin, no reference location information is ever transmitted by the mobile user 50 to GPDIS 20 since GPDIS 20 itself determines the location of the mobile user 50.

By way of contrast, Schwarzwaldner discloses a travel information system 150 which may obtain location information from the onboard information device 100 via its own global positioning receiver 120. (Col. 4, ll. 11-20). Accordingly, Applicant respectfully submits Schwarzwaldner is incompatible with Amin and in fact teaches away from any combination with Amin.

**THE COMBINATION OF AMIN AND SWARZWALDER FAIL TO TEACH OR SUGGEST THE LIMITATIONS PRESENT IN APPLICANTS CLAIMS.**

Applicant's independent claims 42 and 47 explicitly recite a wireless communication system in which "*location information*" and "*user specified price criterion*" are transmitted to another device. Applicant respectfully submits that Amin's global positioning directed information system 20 indisputably determines the location of a user without any location information being provided by a user or mobile device. (Col. 2, ll. 60-63 and col. 3, ll. 37-38). Thus Amin, which is cited as teaching all the limitations of Applicant's rejected claims with the exception of "*user specified price criterion*" teaches the direct opposite of what is claimed by Applicant; namely *location information and user specified price criterion* being transmitted by the wireless communication device.

With regard to Applicant's independent claim 38, there has been no showing, and it appears the Office Action has entirely overlooked Applicant's claimed limitation of *identifying a reference location substantially at the same time of receiving the one or more price criteria*. Since Amin admittedly never receives any user specified price criteria, and since Schwarzwaldner only mentions a "user may specify that only hotels with a predetermined price rand be provided to the user by the onboard information device 100" in connection with a user profile 110 "stored within a memory of a travel information system 150," there is simply no basis to allege that the

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combination of Amin and Schwarzwaldner discloses identifying a reference location substantially at the same time of receiving the one or more price criteria.

Lastly, the Office Action expressly admits that neither Amin nor Schwarzwaldner discloses the limitations present in claims 44 and 46 respectively relating to *a non-volatile memory and a price of fuel*. (6/14/06 Final Office Action pgs. 4-5). Therefore, since the cited references, even in combination, admittedly fail to teach or suggest each and every limitation present in claims 44 and 46, the fact that *prima facie* obviousness has not been established for these claims has already been expressly admitted by the Office Action. (See MPEP 2143 and *In re Vaeck*).

Because the cited references are incompatible to combine with one another and therefore teach away from any proposed combination and since Amin and Schwarzwaldner, taken alone or in combination, admittedly fail to teach or suggest all of the limitations present in Applicant's claims, *prima facie* obviousness has not been established. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection based on Amin and Schwarzwaldner.

2. Claims 39 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Amin in view of Schwarzwaldner in further view of U.S. Patent 6,397,040 to Titmuss et al. (hereinafter "Titmuss").

Titmuss was cited by the Office Action to teach a location input into a portable device by a user. The Office Action alleges it would be obvious to combine the technique disclosed by Titmuss with the combination of Amin and Schwarzwaldner "because it would provide up to date information as desired." (6/14/06 Office Action pg. 7). Applicant respectfully disagrees.

Applicant respectfully submits that since Amin relies explicitly on the use of GPDIS system 20 to track a mobile user's location, it already 'provides up to date information [regarding

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the location of a user or mobile device] as desired.' Since Amin uses GPS explicitly to determine reference location information using a "smart card" to track a user is entirely redundant and unnecessary. (See col. 5, ll. 1-8 of Titmuss regarding tracking a user's position). Accordingly, the skilled artisan would not have any motivation to supplant the GPS tracking of Amin, for which its "global positioning directed information system" (GPDIS) 20 is entirely based, with the communication transponder techniques discussed in Titmuss. Instead, it appears the motivation to ignore the express teachings of Amin and modify with the location updating techniques of Titmuss is based solely in an attempt to reconstruct Applicant's claims in piecemeal fashion using the improper hindsight of Applicant's disclosure as a guide. Conclusions based upon the improper hindsight of an Applicant's disclosure can never establish *prima facie* obviousness. Since there is no proper motivation to modify Amin and Schwarzwaldner with Titmuss, *prima facie* obviousness has not been established.

Applicant also points out that a user turning a cellular telephone on is not remotely analogous to Applicant's claimed limitation of *a location being input into a portable device by the user*, as presently recited in Applicant's claim 39.

With respect to claim 43, Applicant disagrees with the Office Action allegations that Titmuss discloses sending "consumer information including a name of at least one vendor and an associated location of the at least one vendor." The cited passage of Titmuss actually states that an information source description is returned which includes "the name of the information source, a summary of its contents, its address and its locality record." Col. 6, ll. 33-35. There is no mention of any "vendor" by Titmuss; rather the cited passage relates to providing a name of an "information source from which information is provided to users via a telecommunications system." (Abstract). The list of information sources "allow the user to select an information source of interest and thereby to access information from the source." (Abstract). Accordingly, even in combination the cited references fail to teach or suggest the limitations present in Applicant's claims 39 and 43. Since Amin, Schwarzwaldner and Titmuss, taken alone or in

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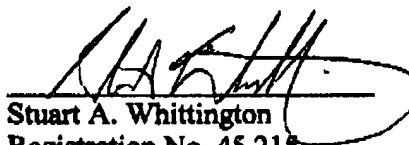
combination, fail to teach or suggest the limitations present in Applicant's claims 39 and 43, *prima facie* obviousness has not been established.

### **CONCLUSION**

In view of the foregoing allowance of this application is believed to be in order, and such action is hereby solicited. If any issues arise which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221**.

Respectfully submitted,

  
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